REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed August 23, 2005 ("Office Action"). At the time of the Office Action, Claims 1-26 were pending in the Application. In the Office Action, the Examiner rejects Claims 1-26. Applicants cancels Claims 1-26 and adds new Claims 27-71. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Claims 27-34, 43-49, and 58-64 are Allowable over the Cited Art

New independent Claim 27 recites:

> A method for preventing hostile use of computer resources by an application running on a workstation, comprising:
> providing a filter on a workstation for receiving internal requests for computer resources resident on the workstation;
> receiving at the filter a request for access identifying a computer resource resident on the workstation, the request for access generated by an unspecified application downloaded to the workstation from a source external to the workstation, the unspecified application not identifiable in a pre-set list of hostile applications;
> determining whether the requested computer resource is on a list of one or more computer resources that are not accessible to unspecified applications;
> allowing access to the requested computer resource if the requested computer resource is not on the list; and
> preventing access to the requested computer resource if the requested computer resource is on the list.

Applicant respectfully submits that the proposed *Touboul-Hayman* combination does not disclose, teach, or suggest the combination of features and operations recited in Applicants' Claim 27.

For example, Applicants respectfully submit that the proposed *Touboul-Hayman* combination does not disclose, teach, or suggest "receiving at the filter [on a workstation] a request for access identifying a computer resource resident on the workstation, the

request for access generated by an unspecified application downloaded to the workstation from a source external to the workstation, the unspecified application not identifiable in a pre-set list of hostile applications," as recited in new independent Claim 27. In the Office Action, the Examiner acknowledges that *Touboul* does not "explicitly disclose when unspecified application [run] on the workstation, preventing the application from accessing any resource directly." (Office Action, page 6). In fact, *Touboul* discloses an "internal network security system 110 [that] examines Downloadables received from external computer network 105, and prevents Downloadables deemed suspicious from reaching the internal computer network." (Column 3, lines 9-12). Thus, *Touboul* is a network based application designed to prevent hostile Downloadables from breaching the internal network. Accordingly, Applicant submits that *Touboul* can not be said to disclose, teach, or suggest that "the request for access [is] generated by an unspecified application downloaded to the workstation from a source external to the workstation" and that "the unspecified application [on the workstation] is not identifiable in a pre-set list of hostile applications," as recited in new Claim 27.

Applicants further submit that this deficiency is not cured by the disclosure of *Hayman*. To the contrary, *Hayman* discloses "a security system for a computer system in which specific limitations are imposed on who has access to exactly what computer functions and data on the computer system." (Column 1, lines 48-51). Specifically, "different privileges [are assigned] to each user depending on the particular job which that user is to do on the computer system." (Column 1, lines 57-61). "Also, security labels are placed on each data file or other system resource, and on each user process." (Column 1, lines 62-63). "A hierarchy of labels is created ranging from highly secret to commonly accessible and strict polices are enforced by the security system based on these labels to determine who has what type of access to which data files or other system resource." (Column 1, line 63 through Column 2, line 1). "According to the invention, a range of these labels is assigned to a particular user process to define a clearance range in which the process is allowed to operate." (Column 2, lines 2-4). Accordingly, the *Hayman* system is limited to determining the permissibility of user-requested computer functions on a user-

by-user basis. As a result, *Hayman* also does not disclose, teach, or suggest "receiving at the filter [on a workstation] a request for access identifying a computer resource resident on the workstation, the request for access generated by an unspecified application downloaded to the workstation from a source external to the workstation, the unspecified application not identifiable in a pre-set list of hostile applications," as recited in new independent Claim 27.

Independent Claims 42 and 57 recite certain features that are analogous to those discussed above. For example, Claim 42 recites a workstation that includes "a memory operable to store one or more applications, at least one application comprising an unspecified application received from the network as a downloadable application, the unspecified application not identifiable in a pre-set list of hostile applications" and "a processor . . . operable to . . . in response to a request received from the unspecified application, determine whether a requested computer resource is on a list of one or more computer resources that are not accessible to any unspecified applications." Claim 57 recites logic operable when executed to "receive at the filter a request for access identifying a computer resource resident on the workstation, the request for access generated by an unspecified application downloaded to the workstation from a source external to the workstation, the unspecified application not identifiable in a pre-set list of hostile applications." Accordingly, for reasons similar to those discussed above, Applicants respectfully submit that the proposed *Touboul-Hayman* combination does not disclose, teach, or suggest each and every limitation of Applicants' Claims 42 and 57.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 27, 42, and 57, together with Claims 28-34, 43-49, and 58-64 that depend from Claims 27, 42, and 57, respectively.

Claims 35-41, 50-56, and 65-71 are Allowable over the Cited Art

New independent Claim 35 recites:

A method for preventing hostile use of computer resources by an application running on a workstation, comprising:

    providing a filter on a workstation for receiving internal requests for computer resources resident on the workstation;

    receiving at the filter a request for access from an application resident on the workstation, the request for access identifying a computer resource resident on the workstation,

    determining if the request for access has exceeded a pre-set threshold identifying a limited number of processes that may be initiated by the application;

    allowing access to the requested computer resource if the request for access has not exceeded the pre-set threshold; and

    preventing access to the requested computer resource if the request for access has exceeded the pre-set threshold.

Applicant respectfully submits that the proposed *Touboul-Hayman* combination does not disclose, teach, or suggest each and every limitation of Applicants' Claim 35.

For example, at a minimum, the proposed *Touboul-Hayman* combination does not disclose, teach, or suggest "receiving at the filter a request for access from an application resident on the workstation, the request for access identifying a computer resource resident on the workstation" and "determining if the request for access has exceeded a pre-set threshold identifying a limited number of processes that may be initiated by the application," as recited in new independent Claim 35. As discussed above, *Touboul* is limited to a network based application designed to prevent hostile Downloadables from breaching the internal network. Furthermore, for determining whether to allow or block a Downloadable, *Touboul* merely discloses that the following tests may be performed: (1) a comparison with known hostile and non-hostile Downloadables; (2) a comparison with Downloadables to be blocked or allowed per administrative override; (3) a comparison of the Downloadable security profile data against access control lists; (4) a comparison of a certificate embodied in the Downloadable against trusted certificates; and (5) a comparison of the URL from which the Downloadable originated against trusted and untrusted URLS. (Column 2, lines 10-20). Accordingly, Applicant submits that *Touboul* does not disclose, teach, or suggest "determining if the request for access has exceeded a

pre-set threshold identifying a limited number of processes that may be initiated by the application," as recited in new independent Claim 35.

Applicants further submit that this deficiency is not cured by the disclosure of *Hayman*. As discussed above, *Hayman* discloses "a security system for a computer system in which specific limitations are imposed on who has access to exactly what computer functions and data on the computer system." (Column 1, lines 48-51). Specifically, "[a] hierarchy of labels is created ranging from highly secret to commonly accessible and strict polices are enforced by the security system based on these labels to determine who has what type of access to which data files or other system resource." (Column 1, line 63 through Column 2, line 1). "According to the invention, a range of these labels is assigned to a particular user process to define a clearance range in which the process is allowed to operate." (Column 2, lines 2-4). As a result, *Hayman* also does not disclose, teach, or suggest "receiving at the filter a request for access from an application resident on the workstation, the request for access identifying a computer resource resident on the workstation" and "determining if the request for access has exceeded a pre-set threshold identifying a limited number of processes that may be initiated by the application," as recited in new independent Claim 35.

Independent Claims 50 and 65 recite certain features that are analogous to those discussed above. For example, Claim 50 recites a workstation that includes a processor that "in response to a received request for access" is operable to "determine if the request has exceeded a pre-set threshold identifying a limited number of processes that may be initiated by an application." Claim 65 recites logic operable when executed to "receive at the filter a request for access from an application resident on the workstation, the request for access identifying a computer resource resident on the workstation" and "determine if the request for access has exceeded a pre-set threshold identifying a limited number of processes that may be initiated by the application." Accordingly, for reasons similar to those discussed above, Applicants respectfully submit that the proposed *Touboul-Hayman*

combination does not disclose, teach, or suggest each and every limitation of Applicants' Claims 50 and 65.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 35, 50, and 65, together with Claims 36-41, 51-56, and 66-71 that depend from Claims 35, 50, and 65, respectively.

The Proposed *Touboul-Hayman* Combination is Improper

Assuming for purposes of argument only that the proposed combination discloses the limitations of Applicants' Claims 27-71 (which Applicants dispute above), the Examiner has not cited language in either reference or within information commonly known to those skilled in the art that provides the necessary motivation or suggestion to combine these two references. Additionally, one of ordinary skill in the art would not have been motivated to make the proposed combination.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an Applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined

does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.[1] According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the

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[1] Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab,* 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab,* the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a motivation to combine the references that create the case of obviousness. *See id. See also, e.g., Grain Processing Corp. v. American Maize-Products,* 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak,* the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

> Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

In the Final Office Action, the Examiner acknowledges that *Touboul* does not disclose "when unspecified application runs on the workstation, preventing the application from accessing any resource directly." (Final Office Action, page 6). The Examiner speculates, however, that "it would have been obvious . . . to employ the use of preventing unspecified application from accessing any resource directly in the system of *Touboul* as *Hayman* teaches to effectively protect computer resources." (Final Office Action, page 6). Applicants respectfully submit that the Examiner's summary conclusion amounts to mere

speculation and does not provide the suggestion or motivation necessary to make the proposed combination.[2] The mere possibility that the security system of *Hayman* might improve the system of *Touboul*, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to modify the teachings of *Touboul*. Applicants respectfully submit that in making this unobvious leap the Examiner has used the type of hindsight reconstruction explicitly forbidden by the M.P.E.P. and Federal Circuit.

Furthermore, Applicants respectfully submit that one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to make the proposed *Touboul-Hayman* combination. Applicants acknowledge that *Touboul* and *Hayman* relate generally to security systems. Applicants respectfully submit, however, that this is both the beginning and ending of any similarity between the two references. Whereas *Touboul* relates a network-based application that prevents hostile applications from breaching an internal network (Column 3, lines 9-12), *Hayman* relates to determining the permissibility of user-requested computer functions on a user-by-user basis. (Column 1, line 48 through Column 2, lines 2-4). Thus, the solution proposed by *Hayman* (restricting access to files "so that only users who posses certain privileges can access to the file") is designed to prevent all users from having total access to the system. Furthermore, there is no explicit or implicit reference in either reference which would suggest to one of ordinary skill to combine the network-based security system of *Touboul* with the user-based system of *Hayman*. In this respect, Applicants respectfully submit that the references are non-analogous art and, because not related, an improper combination.

For at least these reasons, Applicants respectfully submit that the proposed *Touboul-Hayman* combination is improper.

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[2] If the Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining *Touboul* and *Hayman*, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine *Touboul* and *Hayman*, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.
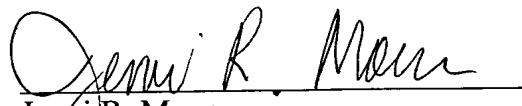
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants enclose a check in the amount of $950.00 for additional claims. Applicants believe that no other fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

Jenni R. Moen
Reg. No. 52,038

Date: October 21, 2005

Correspondence Address:

at Customer No.   **05073**